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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/029,830	03/10/1998	PEET KASK	P61813USO	6621

7590 11/26/2002

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WASHINGTON, DC 20004

[REDACTED] EXAMINER

BAKER, MAURIE GARCIA

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

1639

DATE MAILED: 11/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/029,830	Applicant(s) Kask
Examiner Maurie G. Baker, Ph.D.	Art Unit 1639



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1)  Responsive to communication(s) filed on Sep 13, 2002
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.
- Disposition of Claims
- 4)  Claim(s) 29-76 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) \_\_\_\_\_ is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims 29-76 are subject to restriction and/or election requirement.

### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a)  All b)  Some\* c)  None of:
1.  Certified copies of the priority documents have been received.
  2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.
- 15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1)  Notice of References Cited (PTO-892)      4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      5)  Notice of Informal Patent Application (PTO-152)
- 3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      6)  Other: \_\_\_\_\_

## DETAILED ACTION

**Please note:** The number of Art Unit 1627 has been changed to 1639. Please direct all correspondence for this case to Art Unit 1639.

**Also Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1639 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-308-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

### *Continued Prosecution Application*

1. The request filed on December 18, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No.: 09/029,830 is acceptable (after submission of requirements on September 13, 2002) and a CPA has been established. An action on the CPA follows.
  
2. Applicant's amendment filed September 13, 2002 (Paper No. 22) has been entered. Claims 1-20 were cancelled and claims 29-76 were added. Thus, claims 29-76 are pending.

### *Election/Restriction*

3. Applicant has cancelled all previously examined claims and presented new claims. These claims contain limitations not originally present and thus the scope of the claims has changed. Due to the newly added limitations, a species election is deemed necessary, for purposes of search.

4. Also, see MPEP 819, reproduced in part below (emphasis added):

Where an application filed under 37 CFR 1.53(d), a continued prosecution application (CPA), is a continuation and not a divisional, or where an application filed under former 37 CFR 1.62, File Wrapper Continuation (FWC), is a continuation and not a divisional or C-I-P, an express election made in the prior application in reply to a restriction requirement carries over to the CPA or FWC application unless otherwise indicated by applicant. Where there is no indication in the CPA or FWC application that a change in election is desired, the examiner's first action should include a repetition of the restriction requirement made in the prior application to the extent it is still applicable in the CPA or FWC application and a statement that prosecution is being continued on the invention elected and prosecuted by applicant in the prior application. Examples of what is meant by the phrase "otherwise indicated by applicant" would be where the CPA or FWC is filed as (1) a divisional or (2) a continuation and includes an amendment filed prior to first action in the CPA or FWC adding claims to an invention not previously elected. In each of these examples the **examiner should make a new restriction requirement** in the first action.

5. The claims of this application contain patentably distinct species of the claimed invention. Election is required as follows. Claim 29 is generic. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species (for each of the below groups), even though this requirement is traversed.

6. Please elect one species from each group below. There are *seven* (7) groups.

Group 1: Specific sample analyzed (distinct species present in claims 40-49)

Applicant is required to elect, for purposes of search, **a specific sample that is analyzed by the claimed method**. All of the characteristics of the "particles in the sample" must be set forth, including the number of particle species (e.g. claim 41) and their properties.

Group 2: Specific detection means

Applicant is required to elect, for purposes of search, **a specific detection means used in the claimed method**. Note that all of the parameters of the detection means must also be set forth.

Group 3: Specific distribution function of the number of photon counts

Applicant is required to elect, for purposes of search, **a specific distribution function of the number of photon counts used in the claimed method**. Note that all of the modeling parameters must also be set forth.

Group 4: Specific distribution function of specific brightness

Applicant is required to elect, for purposes of search, *a specific distribution function of specific brightness used in the claimed method.*

Note that all of the modeling parameters must also be set forth.

Group 5: Specific modeling method

Applicant is required to elect, for purposes of search, *a specific modeling method used in the claimed method* to provide fit between experimental and expected distribution functions. Note that all of the modeling parameters must also be set forth.

Group 6: Specific spatial brightness function

Applicant is required to elect, for purposes of search, *a specific spatial brightness function used in the claimed method.* Note that all of the modeling parameters must also be set forth.

Group 7: Arrangement of measurement volumes

Applicant is required to elect, for purposes of search, *a specific arrangement of measurement volumes used in the claimed method* from those set forth in claims 56-59.

\*\* Please note that to be fully responsive, applicant must provide *a listing of all claims readable* on the elected species. See also paragraph 10.

7. The examiner recognizes that the invention is drawn to a method “for characterizing a sample”, however, the structure of the samples characterized as well as the particular method steps must be defined as the claims encompass a variety of patentably distinct species. The different species of sample and method steps would merit separate and burdensome searches. Thus, a specific and detailed election from each of the above should be made, *for purposes of search.*

8. The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting

materials from which they are made and/or the steps and materials for carrying them out. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter. The different species would require different searches and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden.

9. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

10. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

11. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

12. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

13. Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:00 to 6:30 and alternate Fridays.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew J. Wang, can be reached at (703) 306- 3217. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.  
November 23, 2002



MAURIE GARCIA BAKER, Ph.D.  
PATENT EXAMINER



# RESTRICTION ELECTION FACSIMILE TRANSMISSION

DATE:

FROM/ATTORNEY:

FIRM:

PAGES, INCLUDING COVERSHEET:

PHONE NUMBER:

TO EXAMINER: Maurie Garcia Baker, Ph.D.

ART UNIT: 1639

SERIAL NUMBER:

FAX/TELECOPIER NUMBER: (703) 308-4315

**PLEASE NOTE: THIS FACSIMILE NUMBER IS TO BE USED ONLY  
FOR RESPONSES TO RESTRICTIONS.**

COMMENTS: \_\_\_\_\_  
\_\_\_\_\_  
\_\_\_\_\_

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